

REMARKS

This responds to the Office Action mailed on November 16, 2006.

Claims 13 and 26 are amended, no claims are canceled, and no claims are added; as a result, claims 1-15 and 19-26 are now pending in this application. The amendment of claims 13 and 26 are supported by the specification at page 11, lines 4-7.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement and a 1449 Form on August 15, 2005 and a Supplemental Information Disclosure Statement and a 1449 Form on September 25, 2006. The Examiner initialed all but three of the references cited therein. Attached for Examiner's reference are copies of the references not initialed by Examiner. Applicants respectfully request that initialed copies of the 1449 forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

§102 Rejection of the Claims

Claims 1-11, 13, 15 and 19-26 were rejected under 35 U.S.C. § 102(e) for anticipation by Langheinrich et al. (U.S. 6,654,725, hereinafter "Langheinrich").

Applicants respectfully submit that the Office Action does not make out a *prima Facie* case of anticipation for the following reasons:

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, -22 1 USPQ 48 1,485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (Emphasis Added).

With respect to claims 13 and 26, claim 13 recites:

A computer-readable medium having stored thereon executable instructions for causing a computer to perform a utility program for selecting images for a markup language document comprising:
determining a number of images to display in the markup language document;
obtaining a set of random numbers, the set containing a plurality of random numbers, a number of the plurality of random numbers being equal to the determined number of images;
retrieving a set of images from a group of images using the set of random numbers; and
placing the set of retrieved images in the markup language document.
(Emphasis Added)

Langheinrich provides a system and method for customized advertisement selection and delivery on the World Wide Web (WWW) upon the Internet. The advertising system has a database server which stores advertisements and their campaign information, and an advertisement server which generates electronic advertisements available to a client system. (Abstract) The Office Action references the following text from Langheinrich:

“The advertisement server 103 handles the incoming requests from clients to deliver advertisements . . . Advertisers can contact a maintenance server 106 that allows direct access to the advertisement information stored in the database server 104. . . . Note that the initial search page 13 already features a banner advertisement 11 that has been selected and supplied by the advertisement server 103 (FIG. 1), not the publisher's server 101 . . . ”
(Langheinrich, Col. 4, lines 20-58)

The following text may also be relevant:

“ . . . After the user requests a page [1] from the content server 101, the server executes a script . . . the publisher's script uses [2] the advertisement server selection API 119 to obtain an advertisement ID for the given customization parameters (for example the search keyword). . . . This advertisement ID information can then be embedded into the HTML image tag that is placed on the results page where the advertisement will be displayed. . . . ”

(Langheinrich, Col. 6, lines 7-63) (Emphasis Added)

According to the above texts, Langheinrich describes which servers handle the clients' requests; that the initial search page features a banner advertisement; an advertisement ID is obtained for the search keyword and that the advertisement ID is embedded into the image tag on the result page. However, the above quotes do not teach "determining a number of images to display in the markup language document," as recited in claim 13. Langheinrich further describes:

"Using the extracted parameters, the database system 104 is queried through the database (DB) API 118 to provide a list of display probabilities for all available advertisements in the system . . . For each value of a customization variable, this list of probabilities for each advertisement has to add up to 1.0, i.e. in every case the system has to be able to choose one and only one of the available advertisements. . . . the system chooses a random advertisement according to the given probabilities (weight) 2005. Once an advertisement ID (ad ID) has been chosen . . . this can then either be used to directly query the database for image data (event [7] in FIG. 9B), or to embed an advertisement ID parameter into a request string for an image . . ."

(Langheinrich, Col. 7, lines 64 to Col. 8 lines 1-18) (Emphasis Added)

As stated in the above quote, Langheinrich chooses one and only one advertisement based on display probability provided by a data base system. However, Langheinrich does not disclose "obtaining a set of random numbers, the set containing a plurality of random numbers, a number of the plurality of random numbers being equal to the determined number of images," as recited in claim 13.

The Office Action at page 15 part b. states: "Langheinrich's teaching "the remaining advertisements will then be selected randomly" (col. 1, lines 16-46); "grouping related advertisements into families and selecting among families instead of single advertisements " (col. 3, lines 21-37); and "the system chooses a random advertisement" (col.8, lines 1-18) does read-on the claimed limitations." The Applicants respectfully traverse the allegation, because none of the cited passages disclose the above limitation. As such, at least for the reasons set forth above, Langheinrich fails to teach or suggest each and every elements of claim 13. Therefore, Applicants submit that claim 13 and its dependent claim 15 are allowable and the rejection under 35 U.S.C. 102(e) should be withdrawn. Claim 26 presents substantially the same limitations as claim 13, thus at least

for the reasons noted above claim 26 is allowable and it is requested that the claim rejection under 35 U.S.C. 102(e) be withdrawn.

Claim 19 recites “*wherein the utility program causes the processing unit to determine a number of images to display in the markup language document, select the number of images from a group of images.*” Thus, at least for the reasons provided above (e.g., that Langheinrich chooses one and only one advertisement based on display probability provided by a data base system) , claim 19 and its dependent claims 20-24 are not anticipated by Langheinrich and are allowable.

With respect to claims 1 and 25, these claims include substantially the same limitation as discussed above with regards to claim 19, and which is argued not to be disclosed by Langheinrich.

In addition, claim 1 recites “*selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction; and placing, by the utility program, the pre-determined number of images in the markup language document at locations defined in the instruction.*” (Emphasis Added).

The Office Action cites the following text from Langheinrich:

“[T]he system is able to automatically adapt to usage pattern. Advertisers simply have to register their advertisement with the system and can leave advertisement targeting to the automated learning system. However, the advertiser remains in full control by being able to specify, an arbitrary number of display constraints. The system will attempt to maximize the click-through for each single advertisement by relying on past experience. Performance can further be increased by grouping related advertisements into families and selecting among families instead of single advertisements”
(col.3, lines 21-37 and col. 4, lines 21-28). (Emphasis Added)

The above quote teaches that Langheinrich’s system automatically adapts to usage pattern and maximizes the click through for each single advertisement by relying on past experience. In contrast claim 1 requires “*selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction.*” As such, Applicants respectfully submit that at least for the above reasons, Langheinrich fails to teach each and every element of claim 1. Thus

claim 1 and its dependent claims 2-11 are allowable and the claims rejections under 35 U.S.C. 102(e) should be withdrawn.

§103 Rejection of the Claims

Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Langheinrich et al. in view of McCollom et al. (U.S. 6,925,444, hereinafter “McCollom”).

McCollom is directed to a system and method to create and share purchasing lists in a network system. The system and method utilize a consumer user interface. The consumer user interface provides the consumer with the ability to create a purchase list by receiving advertisement data on the consumer device. (Abstract) However, the teachings of McCollom, alone or in combination with Langheinrich, fail to disclose or suggest “selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction,” as recited in claim 1. Claim 12 includes this feature by virtue of being dependent on claim 1. Thus, at least for the above reason, claim 12 is patentable in view of McCollom and Langheinrich combination, and should be allowed.

With respect to claim 14, the teachings of McCollom, alone or in combination with Langheinrich, fail to disclose or suggest “determining a number of images to display in the markup language document; obtaining a set of random numbers, the set containing a plurality of random numbers, a number of the plurality of random numbers being equal to the determined number of images; retrieving a set of images from a group of images using the set of random numbers;” as recited in claim 13. Claim 14 includes these limitations by virtue of being dependent on claim 13. Therefore, at least for the reasons set forth above, claim 14 is patentable in view of McCollom and Langheinrich combination, and the claim rejection under 35 U.S.C. 103(a) should be withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at 408-278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JENNIFER PEARSON ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4053

Date March 6, 2007

By

/ Ali Miresghii /

Ali Miresghii

Reg. No. 58,726

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7 day of March 2007.

Peter R. Keffani

Name

Peter R. Keffani

Signature